

REMARKS

Claims 1-2, 4-7, 9, 11, 13-14 and 16-18 are pending in this application. By the Office Action, claims 1-17 are rejected under 35 U.S.C. §103. By this Amendment, claim 1 is amended to further clarify the subject matter being claimed, claims 3, 8, 10, 12 and 15 are canceled without prejudice, and claim 18 has been added. Support for the amendments to claim 1 may be found, for example, in original claim 3. Support for newly-added claim 18 may be found, for example, on page 12, lines 13-18, of the present specification. Thus, no new matter is added by the above amendments. In view of at least the following, reconsideration and allowance are respectfully requested.

I. Foreign Priority Under 35 U.S.C. §119

Applicants note that the Office Action does not acknowledge Applicants' claim for foreign priority under 35 U.S.C. §119 or confirm receipt of the certified copies of the foreign priority documents (JP Application No. 2003-405360 and JP Application No. 2003-158038). The claim for foreign priority and certified copies of the foreign priority documents were submitted to the U.S. Patent and Trademark Office on November 29, 2005. Therefore, Applicants respectfully request that the Examiner acknowledge Applicants' claim for foreign priority and confirm receipt of the foreign priority documents in the next Office Action.

II. Information Disclosure Statements

Applicants note that the outstanding Office Action does not include an initiated copy of the Form PTO-1449 corresponding to the Information Disclosure Statement filed on January 30, 2006. Therefore, Applicants respectfully request that the Examiner acknowledge receipt and consideration of the documents listed in that Information Disclosure Statement by initialing the corresponding Form PTO-1449 in the next Office Action.

III. Rejection Under 35 U.S.C. §103

The Office Action rejects claims 1-17 under 35 U.S.C. §103(a) as allegedly being unpatentable over Nishiguchi et al. (JP Publication No. 2003-082172, hereinafter "Nishiguchi") in view of Rodway et al. (WO Publication No. 02/073631, hereinafter "Rodway"). Applicants respectfully traverse the rejection.

Without agreeing with or acquiescing to the rejection, Applicants note that claim 1 has been amended to recite that "the sulfurous antioxidant is an imidazole compound including an atom of sulfur (S)." As acknowledged in the outstanding Office Action, Nishiguchi does not disclose a sulfur-containing imidazole antioxidant (*see* page 3 of the Office Action). Therefore, the Office Action relies upon Rodway as allegedly disclosing a sulfur-containing imidazole antioxidant.

Although the Office Action asserts that the Abstract and pages 1 and 2 of Rodway disclose mercaptobenzimidazole, the cited section of Rodway only indicates that the disclosed insulation composition contains no mercaptobenzimidazole, and the Experimental Examples in Rodway do not include sulfur-containing imidazole compounds

Thus, Rodway actually *teaches away* from using a sulfur-containing imidazole compound, as recited in independent claim 1. Rodway clearly teaches that the disclosed insulation composition should contain "zero mercaptobenzimidazole" (*see* Rodway, Abstract and page 3, first paragraph). Therefore, Applicants submit that one skilled in the art would not have arrived at the claimed resin composition comprising a sulfur-containing imidazole compound, based on the fact that Rodway would have steered one skilled in the art away from using such sulfur-containing imidazole compound. Sections 2141.02(VI) and 2145(X)(D) of the MPEP indicate that a reference must be considered in its entirety, including disclosures that teach away from the claims, and these sections of the MPEP show that it is improper to combine references where one of the references teaches away from the claims. For these

reasons, Applicants submit that the Office Action improperly combines the teachings of Nishiguchi and Rodway. Therefore, Applicants assert that Nishiguchi and Rodway (alone or in any proper combination) do not render obvious the claimed resin composition, recited in independent claim 1 and dependent claims 2 and 4-17.

Thus, reconsideration and withdrawal of the rejections are respectfully requested.

IV. New Claims

For the reasons discussed above, Applicants submit that Rodway *teaches away* from using mercaptobenzimidazole (see Rodway, Abstract and page 3, first paragraph). Therefore, Applicants assert that one skilled in the art would not have arrived at the claimed resin composition, based on the teachings of Rodway. Newly-added claim 18 recites that the claimed sulfurous antioxidant is "at least one selected from the group consisting of 2-mercaptobenzimidazole, 2-mercaptomethylbenzimidazole, 4-mercaptomethylbenzimidazole, 5-mercaptomethylbenzimidazole, and a zinc salt thereof." Therefore, Applicants submit that the combined teachings of Nishiguchi and Rodway fail to have rendered obvious the combined elements of newly-added claim 18. Accordingly, Applicants assert that newly-added claim 18 recites allowable subject matter, and respectfully request that the Examiner indicate allowance of newly-added claim 18.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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